

Appl. No. : 10/648,184
Filed : January 11, 2005

REMARKS

With this amendment, Claims 1-14, 17-24, and 27-33 are pending in the present application. Claims 2, 17, and 22-24 have been amended and Claims 15-16 and 25-26 have been canceled. In view of the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration of the pending claims of the above-referenced application.

Claim Rejections-35 U.S.C. §112

The Examiner rejected Claims 15, 18, 20, 21, and 27 under 35 U.S.C. §112, first paragraph. The Examiner indicated that these claims are deemed to be broader than the enabling scope of the disclosure because they did not include the limitation of aluminosilicate as the at least first component in the claimed microsphere. The Applicant respectfully disagrees with the Examiner's position. However, in the interest of expediting the prosecution of this application, the Applicant has canceled independent Claim 15 and amended dependent Claims 18, 20, 21, 27 so that they include the limitation of aluminosilicate. Applicant reserves the right to pursue the canceled claims in the future.

Claims Rejections-35 U.S.C. §102(b)

Claims 1-12 and 24-33 stand rejected under 35 U.S.C. §102(b) as being anticipated by Jones et al. (US 4,937,210). However, after carefully reviewing the Jones reference, the Applicant notes that Jones does not teach or suggest each and every limitation recited in independent Claims 1, 24, and 28 of the present application.

Certain preferred embodiments of the Applicant's invention are directed to microspheres designed to be incorporated in a cementitious matrix, which is generally a very caustic environment. The Applicant has found that an alkali metal oxide content of less than about 10% is desirable for the microspheres because it renders the microspheres substantially chemically inert in caustic environments, such as a cement mixture. Jones, on the other hand, is directed to a porous cellular material for supporting and immobilizing biological catalysts. Chemical inertness in caustic environments does not appear to be a concern for Jones, and therefore, it is not addressed in the reference. In the Office Action, the Examiner asserts that since Jones discloses a microsphere having a wall being substantially free of alkali metal ions, it therefore teaches Applicant's alkali metal oxide limitation. Applicant respectfully disagrees with the Examiner's position and submits that the absence of alkali metal ions does not necessitate the

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absence of alkali metal oxide. Alkali metal ions are charged particles such as Na^+ or K^+ while alkali metal oxides are neutral compounds such as Na_2O or K_2O . Not only does Jones fail to disclose microspheres having an alkali metal oxide content of less than about 10%, there is no teaching or suggestion for such a limitation because Jones does not appreciate or address the same problem as certain embodiments of Applicant's invention.

Claim 1 is directed to a synthetic microsphere having an alkali metal oxide content of less than about 10 wt. %. As discussed above, this limitation is not taught or suggested by the cited prior art reference.

Claim 24 is directed to a plurality of synthetic microspheres having an alkali metal oxide content of less than 10% wt. and the microspheres are formulated with aluminosilicate particles having a pre-selected average particle size range of about 0.01 to 50 microns. The Jones reference does not disclose, positively teach, or suggest these limitations. Thus, the Applicant respectfully submits that *Claim 24* is also patentable over Jones.

Claim 28 is directed to a formulation for forming a synthetic microsphere having an alkali metal oxide content of less than about 10% in the resulting synthetic microsphere. As discussed above, nowhere in Jones does it teach or suggest such a limitation. Thus, the Applicant respectfully submits that *Claim 28* is also patentable over Jones.

Accordingly, the Applicant respectfully requests that the rejections of *Claims 1, 24, and 28* be withdrawn.

Claim Rejections – 35 U.S.C. §103

Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Jones above. The Applicant respectfully submits that this rejection is moot in view of Applicant's arguments above that independent claim 1, which *Claim 23* now depends from, is patentable over Jones. Thus, the Applicant respectfully requests the withdrawal of this rejection.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that independent claims 1, 24, and 28 are patentable over the art of record and the remaining claims are also patentable because of their dependency from these claims. As such, the above-referenced application is in condition for allowance and Applicant respectfully requests the same. Should there be any additional

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issues that can be resolved by an examiner's amendment, the Examiner is respectfully requested to call the undersigned at the number shown below. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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